

## **REMARKS/ARGUMENTS**

Claims 2-12 and 14-36 are currently pending in the application. Claims 7, 8, 18, 19, 25, 29-31 and 35 and 36 have been amended. Reconsideration of the rejection of the claims in view of the following remarks is respectfully requested.

### **Claim Objections**

Claims 7, 8, 18 and 19 were objected to in view of various informalities. These informalities were all directed to the improper hyphenation of certain words. The subject claims, along with claim 14, have been amended to correct these informalities.

### **Claim Rejections – 35 USC § 103**

Claims 25-30, 2-12, 31-36 and 14-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,382,353 to Kelly in view of U.S. Patent No. 4,787,188 to Murphy.

Referring to claims 25 and 27, the Examiner is taking the position that Kelly discloses the basic structure for the assembly of reverse furring technique but does not disclose the assembly comprising a plurality of seam plates. The Examiner goes on to state that Murphy discloses stress plates or seam plates for securing a roof member to a roof deck and that it would have been obvious to one of ordinary skill in the art to combine Kelly with Murphy and provide a plurality of seam plates for securely attaching the roofing membranes.

Claim 25, which is one of the two independent claims in the Application, sets forth an assembly for facilitating the fixed mounting of a roof membrane seam plates at predetermined locations upon an underlying roof decking substructure by means of fasteners. The assembly comprises a substrate and a plurality of seam plates. The seam plates are affixed to the substrate independently of the fasteners.

Referring to the Kelly reference, it is noted first that Kelly does not disclose any seam plates and, therefore, there are no seam plates attached to a substrate. Additionally, the fastener or screw in the Reed reference does not in any way serve to secure the membrane. Further, there is no teaching of providing seam plates at predetermined locations or distances along the substrate.

Referring to the Murphy reference, there is neither any teaching or showing in that reference of using a substrate nor is there any teaching providing the seam plate or stress plates affixed to a substrate. Further, there is no teaching of providing predetermined spacing of the seam plates along a substrate.

In order to establish a *prima facie* case of obviousness, a proposed combination of references must meet each and every limitation of the claim. It is submitted that there is no possible combination of the Kelly and Murphy patents that would satisfy this criteria. No matter how the Kelly and Murphy references are combined, the combination would not result in an assembly in which a stress plate or seam plate was attached to the substrate independent of any fastener. Moreover, any such combination would not provide for the positioning of the stress plate or seam plate at predetermined businesses along the substrate.

In view of the fact that the proposed combination does not meet all the limitations of the claim, claim 25 is patentable.

As to claims 26 and 27, such claims are dependent upon claim 25 and are patentable for the reasons advanced in connection with that claim.

Regarding claims 28, 5 and 9-11, the Examiner refers to column 2, line 49, presumably of the Kelly patent, in connection with the claim limitation "wherein said substrate comprises a flattened tubular member and said plurality of seam plates are fixedly secured within said tubular member by means of adhesive material". It is noted that this claim language refers to the shape or configuration of the substrate as a flattened tubular member and to the securing of the seam plates within the substrate by means of adhesive material. The passage referred to by the Examiner at column 2,

line 49, of the Kelly patent simply states that the membrane is adhesively secured to each furring strip. The language in the Kelly patent does not refer to the shape of the "substrate" nor does it refer to the fastening of seam plates to the substrate. The substrate of Kelly is simply an elongated strip of wood or metal having a solid rectangular cross-section. Note, that as discussed above, there are no seam plates disposed in the Kelly patent. Also, the term "heat-sealed" refers to a type of connection and is in fact a structural limitation which should be accorded patentable weight. Thus even if the Murphy patent is combined in some manner with the Kelly patent, such combination would not meet the terms of these claims. Accordingly, claims 28, 5, 9-11 are patentable for these reasons as well as for the reasons advanced in connection with claim 25 above.

Regarding claims 29-30, the Examiner is taking the position that the term fabricated when used in connection with the flexibility of the substrate, is a method limitation and is not germane to the issue of patentability. These claims have been amended so that the substrate is specifically defined as comprising a material that has a sufficient amount of flexibility so as to permit the substrate to be folded. This phrase now defines the structure of the substrate and accordingly must be given patentable weight. As neither the Kelly nor the Murphy patents disclose a substrate having the claimed flexibility, such claims 29-30 are deemed patentable over the combination of these references for this reason, as well as for the reasons advanced in connection with claim 25.

Regarding claims 2-3 is noted that claim 2 specifically recites that the seam plates are fixedly mounted upon the substrate at predeterminedly spaced positions which correspond to the predetermined distances defined between the plurality of spaced crest portions of the underlying corrugated roof decking structure. In the Kelly patent the substrate runs parallel to the crests of the corrugations so that the fasteners connected with a given substrate are all attached to the same crest. In the Murphy patent, there is no disclosure as to how a plurality of stress plates would be configured

in relation to a given substrate, as Murphy does not disclose a substrate. Thus no combination of the Kelly and Murphy patents would meet these claim limitations. Accordingly, claim 2 is patentable for these reasons as well as for the reasons advanced in connection with claim 25.

Claim 3 sets forth that the seam plates are fixedly mounted on a substrate at predetermined spaced positions. In the Kelly patent, there is no stress plate or seam plate attached to the substrate. In the Murphy patent, there is no suggestion of how the plurality of seam plates would be fixed to a substrate, as there is no substrate shown in that patent. Accordingly, claim 3 is patentable for these reasons, as well as the reasons advanced in connection with claim 25.

As to claims 4, 6-8, and 12, claims 4 and 6 set forth a substrate as having a substantially C-shaped cross-sectional configuration comprising an upper planar member disposed atop the plurality of the seam plates and a pair of lower planar flap-type members folded inwardly from opposite side edge portions of the upper planar member. What is considered a substrate in the Kelly patent for the purpose of this rejection is a furring strip. Nowhere in the Kelly patent is it mentioned or suggested that the furring strip could have a C-shaped cross-section.

The Examiner takes the position that this feature would have been a matter of obvious design choice and that applicant has not disclosed the criticality of this feature. However, the issue is not one of criticality, the issue is one of obviousness and there is nothing in the art to suggest that the provision of a C-shaped cross-sectional substrate to which seam plates are attached would have been obvious to one skilled in the art. There does not appear to be any conceivable reason why a skilled designer would ever decide to make the furring strips of Kelly C-shaped. Absent any basis for the assertion that such a structure would be an obvious design choice, claims 4 and 6 are patentable fort this reason as well as for the reasons set forth in connection with claim 25.

Claims 7, 8 and 12 call for projections on the seam plates which will engage the substrate when the seam plates are secured to the roof decking. The Kelly patent does

not disclose any stress plate and accordingly does not disclose a stress plate having prongs. The Murphy patent discloses a stress plate which includes gripping prongs which grip the membrane. However, as is stated in the patent, the membrane is gripped preferably without piercing the membrane. Note the language at column 2, lines 13 – 15 wherein it is stated "The prongs 21 preferably have a length such that they grip a roof membrane, without puncturing entirely through the membrane." Note also the language at column 2, lines 39 – 42 that reads "The stress plate 10 is positioned with the lower surface 12 in contact with the lower sheet 101 in a manner such that the prongs 21 grip the lower sheet 101, without puncturing through the lower sheet". Thus, the arrangement of the Murphy patent is such that the prongs of the stress plate engage the membranes, but do not pass through the membrane. Therefore if the stress plates of Murphy were used with a substrate, the prongs would not engage the substrate. According to the claims, the projections (claim 8) or prong (claim 12) will engage the substrate. Neither the Kelly nor the Murphy patent teaches the arrangement of a seam plate having prongs which engage a substrate and thus, even if combined, any such combination would not meet this claim limitation. Accordingly, claims 7, 8 and 12 are patentable for this reason, as well as the reasons expressed in connection with claim 25.

Claim 31, the second independent claim in the application, sets forth a roof decking assembly which includes a substrate and a plurality of seam plates. The seam plates are affixed to the substrate independently of the fasteners. As set forth above in connection with claim 25, there is no possible combination of the Kelly and Murphy patents which would lead to an assembly in which the seam plate is affixed to the substrate independently of the fasteners. Accordingly, claim 31 is patentable.

In connection with claim 32, claim 32 is deemed patentable for the reasons set forth in connection with claim 26 above as well as the reasons set forth for its parent claim 31.

Claim 33 sets forth that the substrate comprises at least one pair of substrates fixedly connected together along at least one longitudinally extending seam portion. In this connection the Examiner apparently relies upon Figure 1 of the Kelly reference. However, Figure 1 of Kelly shows a plurality of independent substrates 11 spaced from each other. Nowhere are any of the substrate 11 connected along one longitudinally extending seam portion. Accordingly, claim 33 is deemed patentable for this reason as well as for the reasons set forth in connection with claim 31.

Claims 34, 17 and 2-23 were rejected for the reasons set forth in connection with claims 28, 5 and 9-11. As discussed in detail above, claims 28, 5 and 9-13 are patentable and the rejection thereof is not deemed proper. Accordingly, claims 34, 17 and 2-23 are patentable for the same reasons that claims 28, 5 and 9-11 are patentable as discussed above, as well as for the reasons set forth in connection with their parent claims 25 and 31.

Claims 35 and 36 were rejected based upon the reasoning in connection with claims 29-30. As discussed in connection with claims 29-30, none of the patents set forth in that rejection contain a teaching of providing a substrate comprised of a suitable material that has a sufficient amount of flexibility so as to fit the structure to be rolled or folded. Accordingly, claims 35-36 are patentable for the reasons advanced in connection with claims 29-30 as well as for the reasons advanced in connection with the parent independent claim 31.

As to claims 14 and 15, the Examiner refers to the rejection of claims 2 and 3. As discussed above, claims 2 and 3 are deemed patentable and accordingly, claims 14-15 are patentable for the reasons set forth in connection with 2-3, as well as for the reasons set forth in connection with the independent parent claim 31.

Regarding claims 16, 18-20 and 24, the Examiner has referred to the rejections of claims 4, 6-8 and 12. As mentioned above, claims 4, 6-8 and 12, patentably define over the proposed combination of Kelly and Murphy. Accordingly, claims 16, 18-20 and

Appl. No.: 10/775,171  
Amdt. Dated September 17, 2007  
Reply to Office Action of June 19, 2007

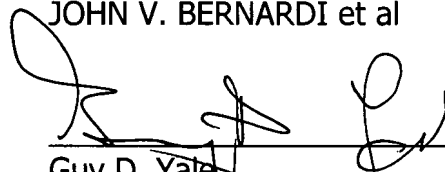
24 are patentable for the reasons set forth in connection with claims 4, 6-8 and 12, as well as for the reasons set forth in connection with their parent claim 16.

### **CONCLUSION**

In view of the above amendments and remarks, it is respectfully submitted that the claims currently in this case patentably define over the art of record taken alone or in any possible combination. Favorable consideration of the claims now in this case is respectfully solicited.

Respectfully submitted,

JOHN V. BERNARDI et al



Guy D. Yale  
Registration No. 29,125  
Alix, Yale & Ristas, LLP  
Attorney for Applicant

Date: September 17, 2007  
750 Main Street  
Hartford, CT 06103-2721  
Our Ref: OMG/168/US  
GDY/HSK/io

G:\AYR saved docs\Filing Docs\O M G\OMG168US\OMG168USResponse091707.doc